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EXAMINER

MAKI, STEVEN D

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/901,472
Filing Date: July 09, 2001
Appellant(s): KASSAB, PETER K.

MAILED
MAY 31 2006
GROUP 1700

Paul J. Nykaza
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3-20-06 appealing from the Office action
mailed 5-3-05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct. The status of the claims is summarized below:

Claims 1, 2, 4-6, 11, 13, 14 and 22-24 are on appeal.

Claim 16 is allowed.

With respect to allowed claim 16, the "reasons for allowance" of claim 16, which is found in paragraph 8 on pages 12-13 of the final office action dated 5-3-05, is represented below for the Board's convenience:

As to allowed claim 16, the terminal disclaimer filed 3-1-04 is proper and has been recorded. Accordingly, the obvious type double patenting rejection over US 6,258,200 (issued by this examiner) has been withdrawn. Although the use of spaced strips of adhesive is known per se as shown by Langen (US 5,290,067) and Travis (US 4,536,423), there is no motivation to modify the static cling sticker assembly of Great Britain '256 (GB 2,217,256) so as to include the step of placing strips of static-cling film coinciding with the strips of adhesive; it being noted that (a) Great Britain '256 (GB 2,217,256), which does not disclose using strips of static-cling film, teaches covering the

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entire surface of the vehicle window sticker (printed sheet) with the static cling film and (b) Great Britain '551 (GB 2,231,551), which also does not disclose using strips of static cling material, teaches using a single static cling sheet (instead of the claimed strips of static cling film) to define an edge margin of static cling material for a vehicle windshield sticker.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

DE 29720696	German 696	June 1998
US 5,622,389	Courtney	April 1997
US 5,290,067	Langen	March 1994
JP 9-97014	Japan 014	April 1997
GB 2,174,233	Great Britain 233	October 1986

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4,935,288	Honaker et al	June 1990
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4,670,490	Yoshida et al	June 1987
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Each of claims 1, 2, 4, 5, 6, 11, 13, 14, 22, 23 and 24 are not entitled to the benefit of the filing date (3-31-99) of the parent application since the subject matter in claims 1, 2, 4-6, 11, 13, 14 and 22-24 (e.g. low tack adhesive) was first introduced in this application filed 7-9-01.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

35 USC 112 second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 23, it is unclear if an intermediary or a sticker assembly (intermediary adhered to window sticker) is being claimed. The preamble appears to suggest that the intermediary is being claimed whereas the language regarding trimming suggests that the sticker assembly is being claimed. If the sticker is not being claimed then the meets and bounds of claim 23 is ambiguous since the "trimming limitation" depends on unclaimed subject matter (the sticker). In other words, "are trimmed" is meaningless if the intermediary being trimmed is not associated with the sticker.

35 USC 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Langen (product)

Claims 1, 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langen in view of Honaker (US 4935288) or Yoshida et al (US 4,670,490).

This rejection addresses product claims 1, 14 and 22. This rejection is not applied against product claims 6 and 23 (the only other product claims) because each of claims 6 and 23 recite "optically clear".

Langen substantially discloses the claimed sticker assembly. See figure 2 and figure 3. In particular, Langen discloses a **"sticker assembly"** comprising:

- **label 12 ("sticker with indicia")**
- **permanent adhesive 35 ("adhesive for fixedly attaching")**
- **tape of label stock 34 ("non-perforated layer")**
- **repositionable adhesive 36 ("low tack adhesive")**
- **release liner 37 ("protective layer")**

The claimed sticker reads on label 12, which has an "indicia bearing surface". The claimed adhesive for attaching corresponds to permanent adhesive 35. The claimed strips of vinyl film correspond to strips 34 of label stock. The claimed low tack adhesive

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reads on the repositionable adhesive 36. The tape of label stock 34 and repositionable adhesive 36 constitute a "mounting / detachment aid" Langen is silent as to the composition of the strips 34 of label stock.

Honaker discloses a label substrate constructed from vinyl label stock. See col. 7 lines 26-27.

Yoshida et al discloses a vinyl chloride composition for films, which may be used for stickers and labels. See col. 3 lines 9-20.

As to claim 1 (sticker assembly), it would have been obvious to one of ordinary skill in the art to use vinyl film for the label stock used to form strips 34 since well known / conventional label stock includes vinyl label stock as evidenced for example by Honaker et al (col. 7 line 27) or Yoshida et al (e.g. col. 3 lines 9-20). In view of Langen's teaching to use "tape 34 (label stock)", one of ordinary skill in the art is instructed by Langen to look to the label art (e.g. Honaker or Yoshida et al) for known label stock. In short, Langen discloses using **label stock** for the two strips and the use of vinyl for **label stock** is suggested by Honaker or Yoshida et al. No unexpected results for using "vinyl" has been shown.

As to the film being trimmed, this product by process language in claim 1 fails to define structure different from that disclosed by Langen since the edges of the strips as in registry with edges 15, 16, 18 after slitting and bursting. See MPEP 2113. The same is true for product claims 14 and 22. In particular, Langen's window sticker comprises a web 12 having four edges (two longitudinal edges 15, 16 and two transverse edges formed by bursting the perforations 18. The edge of the label stock 34 is in registry with

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the longitudinal edge 15 as shown in figures 2 and figure 3. The edge of the label stock 34 is also in registry with the transverse edge formed by bursting the perforations 18. See figure 2, which illustrates the repositionable adhesive 36 in the label stock 34 as being at the transverse edge of the individual window sticker. As to the label stock 34 being vinyl, see Honaker or Yoshida et al. In claim 14, the edges of the strips are in registry with the edges of the label and therefore "undetectable" as claimed.

The limitation of the vinyl film being non-perforate would have been obvious since Langen suggests using continuous uninterrupted non-perforate strips 34. As to the sticker assembly being adapted to be releasably adhered to a receiving surface, Langen teaches releasably adhering the sticker assembly to a window of a car.

German '696 (product and method including trimming)

Claims 1, 2, 4, 5, 6, 11, 13, 14 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over German '696 (DE 29720696) in view of Courtney (US 5622389) and Japan '014 (JP 9-97014) and optionally further in view of at least one the admitted prior art (specification pages 1-3, page 18 lines 12-17), Great Britain '233 (GB 2174233) and Langen (US 5290067).

This rejection addresses all of the claims on appeal.

German '696, directed to a sticker for a car window, discloses sticking a "sticker" on a "window sticker removing aid" (mounting / detachment aid). The window sticker removing aid (mounting / detachment aid) consists of a "transparent foil" (transparent film), which has a "sticky layer" / "adhesive layer" on one side. The adhesive force of

the sticky layer is lower than the adhesive force of the sticker. Hence, German '696 discloses a **sticker assembly** comprising:

sticker for car window ("sticker")

adhesive coating ("strong adhesive")

transparent film ("non-perforated layer")

adhesive layer ("low tack adhesive")

wherein the adhesive force of the adhesive layer on the film is lower than the adhesive force of the adhesive coating of the sticker. German '696 teaches that the sticker assembly *allows easy and complete removal of the sticker from the window without any problem and residue*. German '696's sticker assembly, therefore, is adapted to be releasably adhered to the car window. Since German '696 teaches that the mounting aid can be used to detachably adhere a common sticker to a car window or window at home, one of ordinary skill in the art would readily understand that the sticker has an indicia bearing surface as claimed. See abstract and translation. In a preferred embodiment, German 696 teaches that the majority and most common stickers can be stuck on the foil of the detachment aid. One of the ordinary skill in the art would readily understand from this teaching that if the detachment aid is too small, it cannot completely cover the adhesive of the sticker. One of ordinary skill in the art would also readily understand from this teaching that the detachment aid may have a size larger than a sticker. In view of German 696's disclosure as a whole and especially in view of the description in the protective claim, one of ordinary skill in the art would readily understand that (a) the detachment aid should have a size at least covering the

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adhesive on the sticker and (b) German 696 is not limited to the detachment aid being larger than the sticker (German 696 fails to state "The transparent foil must be larger than the sticker."). With respect to the size of the film, appellant acknowledges: "German '696 is directed to a structure for displaying stickers on an inside of a windshield for viewing through the windshield as is Appellant's application." (page 19 of Brief filed 3-20-06). Appellant also acknowledges "... German '696 states that the film should be larger than the sticker ... German '696 promotes a 'one side fits all' product. German '696 states that the format is selected so that the majority and most common stickers can be stuck on it. (See Declaration of Peter K. Kassab, Paragraph 7.) Thus, the film in German '696 is sized such that it can be used with most stickers. The film, therefore, must be at least slightly larger than the largest stickers to assure its operability. The film cannot be undersized or else the high-tack adhesive on the sticker will extend past the film and be able to contact the receiving surface, thus rendering the film inoperable for its stated purpose." (page 21 of Brief filed 3-20-06). Hence, German '696 substantially discloses the claimed invention. German '696 is silent as to the edges of the film being in registry with the peripheral edges of the sticker.

Courtney, directed to the sticker art, discloses a bumper sticker 12 ("sticker assembly") comprising:

- **substrate with writing ("sticker with indicia")**
- **permanent adhesive ("adhesive for fixedly attaching")**
- **clear plastic mounting sheet 1 ("non-perforated layer")**
- **temporary means 16 for securing
such as Velcro or double-sided adhesive tape**

Courtney trims the mounting sheet 11 so that it matches the shape of the bumper sticker 12. This trimming makes the bumper device 10 ("mounting / detachment aid") become virtually undetectable to the casual observer. The appearance of permanent affixation reduces potential for theft of the sticker. See col. 1 lines 44-47, col. 1 lines 44-47, col. 2 lines 47-57. At col. 2 lines 30-31, Courtney states "It is also within the scope of the invention to mount the bumper sticker on a surface other than a bumper". See col. 2 lines 30-31.

Japan 014, directed to the sticker art, discloses a thermoplastic transparent resin sheet 5, which is poly vinyl chloride. See abstract and machine translation.

As to claims 1 and 2, it would have been obvious to one of ordinary skill in the art to trim the film (a mounting sheet which is used to releasably mount the sticker to a window surface), such that the edges of the film are in registry with the edges of the sticker since (1) German '696's teaching to use the film as a detachment aid for a sticker indicates that the film should have a shape and size at least matching that of the sticker / the adhesive coating on the sticker and (2) Courtney, also directed to a detachment aid for a sticker, teaches adhering a sticker on a mounting sheet (which is used to releasably mount the sticker to a surface) and trimming the mounting sheet to match the shape and size of the sticker *so that the mounting sheet is virtually undetectable to the casual viewer and potential for theft is reduced by the appearance of permanent affixation* (col. 1 lines 61-62, col. 2 lines 24-28, 30-31, 33-46, 50-55).

Furthermore, it would have been obvious to one of ordinary skill in the art to use vinyl for the transparent film of German '696 since vinyl is a known transparent resin to one of

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ordinary skill in the sticker art as evidenced for example by Japan '014. The above rejection constitutes a prima facie case of obviousness. No further modification of German '696 is required by claims 1 and 2.

As to the "adhesive layer on the sticker", "direct contact", "fixedly attaching":

The claimed adhesive layer on the sticker reads on German '696's adhesive having the greater adhesive force. In any event: It would have been obvious to one of ordinary skill in the art to use a sticker having a strong adhesive as the sticker of German '696 such that the strong adhesive is in direct contact with the film and fixedly attaches the sticker to the film since (a) German '696, directed to the sticker art, teaches directly adhering a sticker on transparent film such that the adhesive force of the sticker is greater than the adhesive force of the adhesive layer of the window sticker removing aid (mounting / detachment aid) and (b) a sticker for a car window having a strong adhesive on one side for permanent bonding is well known per se in the sticker art as evidenced by the admitted prior art. Hence, German '696 suggests strongly bonding a sticker to the surface of a transparent film (mounting / detachment aid) and the admitted prior art teaches using a strong adhesive on a sticker for strongly bonding the sticker on a surface. It is acknowledged that the admitted prior art discloses directly sticking the sticker to the window. However, German '696 teaches sticking the sticker directly on the mounting aid so that the sticker is indirectly and releasably adhered to the window.

As to the "low tack adhesive layer": The claimed low tack adhesive layer reads on German '696's adhesive layer the low adhesive force. In any event: The limitation of the adhesive layer being low tack so as to permit releasable adherence / peeling without

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damage would have been obvious to one of ordinary skill in the art in view of (a)

German '696's teaching that the adhesive force of the adhesive layer of the mounting / detachment aid is lower than the adhesive force of the adhesive coating on the sticker so that the adhesive assembly may be easily removed from the window and optionally

(b) Great Britain '233's teaching to use an adhesive having a "lesser degree of adhesion" so a sticker assembly can be removed from a window and/or Langen's teaching to use a repositionable adhesive, such as that manufactured by 3M for Post-It® notes, for a sticker for a window so that the sticker may be removed from the window without leaving adhesive residue on the window. In Great Britain '233 (directed to a sticker assembly for a window), the adhesive for fixedly attaching is between a first side of transparent film 10 and an indicia bearing film 13 and the adhesive permitting removal of the sticker assembly from the window is on a second side of the transparent film 10 (see figure 9 of Great Britain '233). In Langen (directed to a sticker assembly for a window), the adhesive for fixedly attaching (the permanent adhesive 35) is between a first side of label stock 34 and label 12 and the adhesive for permitting removal of the sticker assembly from the window (the repositionable adhesive 36) is on a second side the label stock 34 (see figure 3 of Langen).

As to the indicia bearing surface being viewable through a receiving surface, one of ordinary skill in the art would readily understand that the sticker of German '696 has indicia viewable through a receiving surface since the sticker assembly of German '696 is for a car window. In other words, one of ordinary skill in the art would readily appreciate that the film is transparent in German '233 so that the sticker - including any

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indicia thereon- can be viewed through the transparent film and the window. In any event: It would have been obvious to one of ordinary skill in the art to provide the sticker of German '696's sticker assembly with an indicia bearing surface such that it can be viewed through a receiving surface (e.g. car window / windshield) in view of the admitted prior art's suggestion to view indicia of a sticker through the vehicle window and /or Great Britain '233's suggestion to view indicia (e.g. wording on item 13) of a sticker assembly through both the transparent film 10 of the sticker assembly and a vehicle window.

As to non-perforated / continuous, uninterrupted: German '696's transparent film is considered to be non-perforated, continuous and uninterrupted. In any event: It would have been obvious to provide German '696's transparent film as a non-perforated, continuous, uninterrupted transparent film since German '696, which fails to teach forming holes, teaches using the transparent film as a mounting / detachment aid for a sticker.

As to claims 4, 13 and 22, it would have been an obvious alternative to use a pair of transparent film strips to cover a pair of adhesive strips instead of using one transparent film to cover a complete adhesive coating the entire surface of the sticker in view of (1) the above noted suggestion in German '696 to use transparent film having low tack adhesive as a mounting / detachment aid for known stickers, (2) the admitted prior art's teaching that known stickers include temporary city stickers made from paper having a thin line of adhesive along the side of the sticker rather than a complete adhesive layer across the entire face of the sticker so that the adhesive is not provided

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over the indicia bearing portion (page 18 lines 12-17) and (3) Langen's suggestion to removably secure a sticker to window using spaced strips having repositionable adhesive wherein the indicia is not covered by the repositionable adhesive (figures 2 and 3). The limitation of trimming the strips / the trimmed strips would have been obvious in view of (a) the above noted suggestion from the applied prior art to use a pair of film strips (pair of mounting / detachment aids) instead of one film strip (one mounting / detachment aid) and (2) the above noted teaching to Courtney to trim the mounting sheet material to match the shape and size of the sticker *so that the mounting sheet is virtually undetectable to the casual viewer and potential for theft is reduced by the appearance of permanent affixation* (col. 1 lines 61-62, col. 2 lines 24-28, 3-31, 33-46, 50-55).

As to claim 5, the limitation therein would have been obvious in view of German '696's suggestion to use a foil, which is transparent.

As to the protective layer in claims 6 and 11, it would have been obvious to one of ordinary skill in the art to provide a protective layer on the "low tack" adhesive of German 696's mounting / detachment aid since it is well known / conventional to cover adhesive with a protective layer (release liner / backing sheet), which protects the adhesive prior to removal therefrom as evidenced by at least one of Great Britain 233 (page 1) and Langen (col. 5). Furthermore, it would have been obvious to place the edges of protective layer in registry with the edges of the film and the edges of the sticker in view of (1) the above noted suggestion from at least one of Great Britain and Langen to cover the "low tack" adhesive of German 696's mounting aid with a protective

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sheet and (2) Courtney's teaching to trim edges of a mounting aid so that the mounting aid matches the shape of the sticker. As to claim 6, also note examiner's comments on "optically clear" (claim 5) and Courtney's teachings regarding "undetectable". As to claim 11, also note examiner's comments on claim 2. With respect to the adhesive layer having a strength such that the film cannot be separated from the adhesive without destroying the film and the sticker, note German '696 and optionally the admitted prior art's teaching to use a relatively strong adhesive for the sticker.

As to the protective layer in claim 14, it would have been obvious to provide the German 696's mounting aid with two protective layers as claimed in view of Langen's suggestion to cover first and second strips of repositionable adhesive with first and second strips of protective layers (release liners), which protect the adhesive strips prior to removal therefrom. Furthermore, it would have been obvious to place the edges of the first and second protective layers in registry with the edges of the films and the edges of the sticker in view of (1) the above noted suggestion from Langen to cover first and second strips of adhesive with first and second strips of protective layers (release liners), which protect the adhesive strips prior to removal therefrom and (2) Courtney's teaching to trim edges of a mounting / detachment aid so that the mounting / detachment aid matches the shape of the sticker.

As to claim 23, note examiner's above comments on claim 6. Claim 23 does not exclude the sticker.

As to claim 24, note examiner's above comments on claim 1. With respect to the word "strip", it would have been obvious to use German 696's mounting aid for a sticker

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in strip form since both German 696 and Courtney suggest using a mounting aid for a sticker and Courtney suggests providing in the sticker in the form of a strip. Claim 24 fails to exclude a vinyl strip covering the entire surface of the sticker. Claim 24 fails to require a second strip. With respect to "undetectable", note Courtney's teaching to trim so that the mounting aid is virtually undetectable to the casual observer. With respect to the adhesive layer having a strength such that the film cannot be separated from the adhesive without destroying the film and the sticker, note German '696 and optionally the admitted prior art's teaching to use a relatively strong adhesive for the sticker.

Alternatively: As to claim 24, note examiner's above comments on two strips (claim 22). With respect to "undetectable", note Courtney's teaching to trim so that the mounting aid is virtually undetectable to the casual observer. Claim 24 fails to exclude the second strip.

German 696 (intermediate product)

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over German '696 (DE 29720696) in view of Japan '014 (JP 9-97014) and further in view of at least Great Britain '233 (GB 2174233) and Langen (US 5290067).

This rejection is made since (1) claim 23 does not appear to require the window sticker (see 112 second paragraph rejection of claim 23) and (2) the claimed description of "are trimmed" is a product by process limitation / relates to intended use.

As to claim 23, it would have been obvious to one of ordinary skill in the art to use vinyl for the transparent film of German '696 such that the foil is optically clear since

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(1) German 696 teaches that the foil is transparent and (2) vinyl is a known transparent resin to one of ordinary skill in the sticker art as evidenced for example by Japan '014.

Furthermore, it would have been obvious to one of ordinary skill in the art to provide a protective layer on the "low tack" adhesive of German 696's mounting aid since it is well known / conventional to cover adhesive with a protective layer (release liner / backing sheet), which protects the adhesive prior to removal therefrom as evidenced by at least one of Great Britain 233 (page 1) and Langen (col. 5). The protective layer suggested by at least one of Great Britain 233 and Langen has a size corresponding to the size of the adhesive. In figure 3 of Langen, the protective layer (release liner 37) are in registry with the edges of the low tack adhesive 36, the layer 34, and the strong adhesive. The protective layer (release liner) therefore has a size corresponding to that of the "low tack adhesive".

German 696's mounting aid has edges. The trimming language fails to require edges different from the edges of the foil disclosed by German 696. The protective layer suggested by at least one of Great Britain and Langen also has edges. See for example, figure 3 of Langen.

The above rejection constitutes a prima facie case of obviousness. No further modification of German 696 is required by claim 23.

As to the "low tack adhesive layer": The claimed low tack adhesive layer reads on German '696's adhesive layer having the lower adhesive strength / lower adhesive force. In any event: The limitation of the adhesive layer being low tack so as to permit releasable adherence / peeling without damage would have been obvious to one of

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ordinary skill in the art in view of (a) German '696's teaching that the adhesive force of the adhesive layer is lower than the adhesive force of the adhesive coating on the sticker so that the adhesive assembly may be easily removed from the window and optionally (b) Great Britain '233's teaching to use an adhesive having a "lesser degree of adhesion" so a sticker assembly can be removed from a window and/or Langen's teaching to use a repositionable adhesive, such as that manufactured by 3M for Post-It® notes, for a sticker for a window so that the sticker may be removed from the window without leaving adhesive residue on the window. In Great Britain '233 (directed to a sticker assembly for a window), the adhesive for fixedly attaching is between a first side of transparent film 10 and an indicia bearing film 13 and the adhesive permitting removal of the sticker assembly from the window is on a second side of the transparent film 10 (see figure 9 of Great Britain '233). In Langen (directed to a sticker assembly for a window), the adhesive for fixedly attaching (the permanent adhesive 35) is between a first side of label stock 34 and label 12 and the adhesive for permitting removal of the sticker assembly from the window (the repositionable adhesive 36) is on a second side of the label stock 34 (see figure 3 of Langen).

As to the indicia bearing surface being viewable through a window, one of ordinary skill in the art would readily understand that the sticker of German '696 has indicia viewable through a receiving surface since the sticker assembly of German '696 is for a car window. In other words, one of ordinary skill in the art would readily appreciate that the film is transparent in German '233 so that the sticker - including any indicia thereon- can be viewed through the transparent film and the window. In any

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event: It would have been obvious to one of ordinary skill in the art to provide the sticker of German '696's sticker assembly with an indicia bearing surface such that it can be viewed through a window in view of Great Britain '233's suggestion to view indicia (e.g. wording on item 13) of a sticker assembly through both the transparent film 10 of the sticker assembly and a vehicle window.

As to continuous, uninterrupted: German '696's transparent film is considered to be non-perforated, continuous and uninterrupted. In any event: It would have been obvious to provide German '696's transparent film as a continuous, uninterrupted transparent film since German '696, which fails to teach forming holes, teaches using the transparent film as a mounting aid for a sticker.

(10) Response to Argument

35 USC 112 second paragraph

Appellant argues that the sticker is not being positively claimed in claim 23 since claim 23 recites "are adapted". This argument is not persuasive since claim 23 recites "are trimmed" instead of --are trimmable--. Furthermore, appellant has failed to explain how the meets and bounds of "are trimmed" can be determined if the sticker is not claimed and is thereby not associated with the intermediary.

Langen

Appellant's argument that there is no motivation to combine Langen with Honaker or Yoshida is not persuasive because (1) Langen discloses using **label stock** for the two strips and (2) the use of vinyl for **label stock** is suggested by Honaker or Yoshida et al. No unexpected results for using "vinyl" for the two strips has been shown. In view of

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Langen's teaching to use "tape 34 (label stock)", one of ordinary skill in the art is instructed by Langen to look to the label art (e.g. Honaker or Yoshida et al) for known label stock.

Appellant argues: "There is plainly no disclosure or suggestion of a step of trimming a vinyl film to correspond in size to a sticker." (page 33 of Brief filed 3-20-06, emphasis added). Langen is applied against product claims 1, 14 and 22, which fail to require a "step of trimming". Trimming the label 12 such that the edges of the label stock 34 are in registry with the edges (e.g. edge 15) of the label instead of trimming the edges of the label stock 34 such that the edge of the label stock 34 are in registry with the edges (e.g. edge 15) of the label 12 does not cause Langen's window sticker to be a materially different product than that claimed in product claims 1, 14 and 22.

Appellant argues that the structure of claim 1 is distinguishable from Langen since claim 1 has a trimmed edge and the strip of Langen does not. This argument is not persuasive since the edges of Langen's strips are in registry with the edges of the sticker after slitting and bursting. See MPEP 2113. In particular, Langen's window sticker comprises a web 12 having four edges (two longitudinal edges 15, 16 and two transverse edges formed by bursting the perforations 18). The edge of the label stock 34 is in registry with the longitudinal edge 15 as shown in figures 2 and figure 3. The edge of the label stock 34 is also in registry with the transverse edge formed by bursting the perforations 18. See figure 2, which illustrates the repositionable adhesive 36 on the label stock 34 as being at the transverse edge of the individual window sticker. As to the label stock 34 being vinyl, see Honaker or Yoshida et al.

Applicant argues that there is no need for another trimming operation in Langen. This argument is off point. The article claims fail to require a trimming operation.

With respect to applicant's arguments regarding the first protective layer and the second protective layer (claim 14), Langen teaches this subject matter. See release strips 37.

German 696 and Courtney

Appellant acknowledges: "German '696 is directed to a structure for displaying stickers on an inside of a windshield for viewing through the windshield as is Appellant's application." (page 19 of Brief filed 3-20-06). Appellant also acknowledges "... German '696 states that the film should be larger than the sticker ... German '696 promotes a 'one side fits all' product. German '696 states that the format is selected so that the majority and most common stickers can be stuck on it. (See Declaration of Peter K. Kassab, Paragraph 7.) Thus, the film in German '696 is sized such that it can be used with most stickers. The film, therefore, must be at least slightly larger than the largest stickers to assure its operability. The film cannot be undersized or else the high-tack adhesive on the sticker will extend past the film and be able to contact the receiving surface, thus rendering the film inoperable for its stated purpose." (page 21 of Brief filed 3-20-06).

Examiner agrees with appellant that the film of German 696's mounting / detachment aid may be larger than the size of the sticker. The examiner adds the following comments: German 696 and Courtney teach a mounting / detachment aid comprising a sheet having adhesive material which allows detachment. German 696

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and Courtney adhere the mounting / detachment aid to a sticker. The sheet of the mounting / detachment aid can have a larger size than the sticker in German 696 and Courtney. German 696 fails to disclose that the plastic sheet must remain larger than the sticker when the detachment aid having the sticker adhered thereto is bonded to the window. Courtney motivates one of ordinary skill in the art to trim the larger sized plastic sheet such that it matches the shape of the sticker so that the mounting aid becomes virtually detectable.

Appellant argues that German 696 and Courtney are directed to different problems. The examiner disagrees because German 696 and Courtney are directed to the use of a mounting / detachment aid to temporarily attach a sticker to a desired surface.

Appellant argues that the examiner has abandoned his first line of reasoning that German 696 indicates that the film should have a size matching that of the sticker/ the adhesive coating on the sticker. Appellant further argues that this reasoning was vital to the examiner's obviousness conclusion. Appellant is incorrect. In the examiner's opinion, German 696 teaches a sticker assembly, which like that of appellant comprises a "substrate", "adhesive for fixedly attaching", "transparent film" and "low tack adhesive". The combination of the "transparent film" and "low tack adhesive" forms German 696's mounting / detachment aid. Viewed as a whole, German 696's invention was to enable a sticker to attach to a window and then be detached when desired. In order to implement this objective, German 696 covers the "strong adhesive" on the sticker with the detachment aid. Examiner and Appellant are in agreement that the film

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of German 696's detachment aid cannot be smaller than the sticker. See page 21 of Brief filed 3-30-06. Examiner and Appellant are also in agreement that the film of German 696's detachment aid can be larger than the sticker. See page 21 of Brief 3-30-06. In the examiner's opinion, German 696 indicates that the film of the mounting / detachment aid has a shape and size at least that of the adhesive coating of the sticker. The examiner acknowledges that German 696 is silent as to the film of the detachment aid having edges in registry with the edges of the sticker (German 696 was not applied in a 102 rejection against claim 1). In order to reject claim 1, the examiner relies and has relied on German 696's teaching to use the film as a detachment aid. In particular, German 696 teaches adhering the film of the detachment aid to the sticker so that the low tack adhesive instead of the strong adhesive detachably adheres the sticker to a window. The strong adhesive must be covered by the film. Thus, the mounting aid is used (i.e. the function of the mounting aid is) to cover the adhesive on the sticker. The mounting aid therefore has a shape and size at least that of the adhesive coating of the sticker. In order to reject claim 1, the examiner relies on and has relied on Courtney's teaching to trim to a mounting sheet of a mounting / detachment aid so that the mounting sheet matches the shape and size of the sticker. The expected benefit of this trimming per the teachings of Courtney is making the mounting / detachment aid undetectable.

Appellant asserts that German 696 teaches a one size fits all product and that "... the film, therefore, must be at least slightly larger than the largest stickers to assure operability. The film cannot be undersized or else the high-tack adhesive on the

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sticker will extend past the film and be able to contact the receiving surface, thus rendering the film inoperable for its stated purpose". See page 12 of Brief filed 3-30-06. The examiner agrees with appellant that the German 696 teaches that the film of the mounting aid *may* be larger than sticker. This conclusion is supported by evidence including the translation of German 696 and paragraph 7 of Kassab's declaration filed 10-26-04. However, nothing in the translation of German 696 teaches that the mounting aid *must always remain* larger than the sticker. Moreover, Courtney suggests trimming a mounting aid, which is larger than the sticker so that the mounting aid is virtually undetectable to the casual observer. One of ordinary skill in the art is appraised from Courtney of the problem (detectable problem / theft potential problem) of a mounting aid being larger than the sticker and is instructed of the solution (trimming the mounting aid).

Appellant argues that the trimming element of claim 1 is not disclosed or suggested in any of the several references. This argument is not persuasive.

First: German 696 and Courtney both disclose adhering a sticker to a sheet of a removable mounting aid using adhesive of the sticker and detachably mounting this sticker assembly to a surface of a vehicle. Courtney also teaches matching the shape of the mounting aid to the shape of the sticker by **trimming** the mounting aid to place the edges of the mounting aid in registry with the sticker so that the device becomes virtually undetectable to the casual viewer. Courtney motivates one of ordinary skill in the art to trim German 696's mounting aid so that the mounting aid is undetectable and the potential for theft is reduced by the appearance of permanent fixation; applicant

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having presented no convincing argument and/or evidence to the contrary. In short, **the motivation** for combining German 696 and Courtney is making a mounting aid undetectable to the casual viewer and reducing the potential for theft by the appearance of permanent fixation. See col. 1 lines 44-47, col. 1 lines 58-62 and col. 2 lines 47-57 of Courtney.

Second: With respect to **film**, German 696 teaches this subject matter because German 696's mounting aid comprises a "transparent foil" (a "transparent film"). See page 3 of translation for German 696. German 696 also teaches a "low tack adhesive layer" as claimed since the "adhesive strength of the adhesive layer is markedly less than the adhesive strength of the actual sticker". See page 3 of translation for German 696.

Third: With respect to **vinyl**, Japan 014 provides ample suggestion to use polyvinyl chloride as the material for German 696's transparent foil since Japan 014, also directed to the sticker art, suggests using polyvinyl chloride as the material for a transparent sheet. No unexpected results for using a composition comprising "vinyl" for the claimed film has been shown.

Appellant argues that German 696 contains no disclosure for the film to be undetectable and makes no further statements regarding trimming. More properly, Courtney motivates one of the ordinary skill in the art to trim German 696's film so that it is undetectable. This benefit is applicable to German 696 since German 696's film, like Courtney's plastic sheet, is used to in a mounting / detachment aid for temporarily attaching a sticker to a desired surface.

Appellant comments on the attributes of hard vinyl film. None of the appealed claims requires hard vinyl film.

Appellant argues that the resin sheet in Japan 014 is not for the purpose of a film intermediary. This argument is not persuasive since (1) German 696's transparent foil is for the window sticker removing aid and (2) Japan 014, which like German 696 is in the sticker art, suggests using polyvinyl chloride for German 696's film in order to obtain the transparency desired by German 696.

Appellant identifies several advantages of the present invention including using trimming to make the film virtually undetectable to help avoid theft of the sticker assembly. These comments are not persuasive of non-obviousness since using trimming to make the film virtually undetectable to help avoid theft of the sticker assembly is not an unexpected result. See Courtney's teaching to use trimming to make a mounting aid undetectable and thereby reduce potential for theft.

With respect to applicant's comment that Courtney uses Velcro strips, Examiner comments that Courtney suggests using "adhesive materials" such as "double-sided tape". See col. 2 lines 24-27.

Appellant comments that Courtney discloses mounting a bumper sticker on a mounting aid. The examiner agrees that Courtney, like German 696, teaches adhering a mounting aid to a sticker. The examiner adds that Courtney teaches that the sticker may be mounted on surfaces other than a bumper. See col. 2 lines 30-31.

Appellant asserts that trimming is not readily known. Contrary to appellant's arguments, trimming is known. A step of trimming a mounting aid is disclosed by the prior art (i.e. US Patent 5622389 to Courtney).

With respect to protective layer (e.g. claim 6), appellant argues that Courtney does not disclose or suggest using a protective layer or trimming the protective layer along with a film. German 696 teaches a low tack adhesive on the transparent film. The applied prior art to at least one of Langen and Great Britain 233 provide ample suggestion to cover the low tack adhesive of the mounting aid with a release liner and Courtney suggests trimming the mounting aid so that the mounting aid is undetectable. The self evident benefit of using a protective layer (release liner) being protection of the adhesive until use.

Appellant's arguments regarding the use of two strips (e.g. claim 13) instead of one strip are not persuasive since German 696 and Langen fairly suggest obtaining temporary adhesion for the admitted prior art's sticker which has two strips of adhesive by applying two strip mounting aids (each comprising a strip coated with lower strength adhesive) on the two strips of adhesive of the admitted prior art sticker. With respect to the edges being in registry, Langen teaches this subject matter (see figure 2) and Courtney provides strong motivation to place edges in registry to make the mounting aid virtually undetectable to the causal observer / reduce potential for theft. As to the method step of trimming, Courtney teaches this subject matter. See col. 2.

Appellant argues that the Examiner's reasons for allowance of claim 16 equally apply to claim 13. Appellant is incorrect. Claim 16 requires static cling whereas claim 13 requires low tack adhesive. Claims 13 and 16 are directed to different inventions.

claim 23 (German 696, intermediary)

Appellant argues that "... the edges of the film in claim 23 are structurally different from the edges in German 696 as German 696's edges are not trimmed" (page 36 of Brief filed 3-30-06, emphasis added). The examiner agrees that German 696's film has edges. The product by process language in claim 23 of the edges being formed by trimming does not require a materially different product than that disclosed by German 696.

Appellant also argues that Great Britain and Langen do not disclose trimming a vinyl film and protective film is not persuasive since (1) claim 23 fails to require a step of trimming and (2) at least one of Langen and Great Britain 233 suggests using a release liner (protective layer) corresponding in size to the adhesive. See for example figure 3 of Langen.

132 declaration (invention has been well received in marketplace)

The declaration under 37 CFR 1.132 filed 10-26-04 is insufficient to overcome the rejection of claims 1, 2, 4-6, 11, 13, 14 and 22-24 as set forth above in this Office action because:

(1) The solution ("intermediary layer including low tack adhesive") to the problem of difficult to remove stickers is found in the prior art. See German 696 and Langen.

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(2) Courtney teaches trimming a transparent sheet of a mounting aid to make the mounting aid virtually undetectable - US Patent 5,622,389 is evidence showing that trimming is known concept in the field of stickers.

(3) The relationship between "My product" and the claimed invention is not clear.

(4) It appears that the evidence in the declaration is not commensurate in scope with the claims since sales of the product appear to be for the untrimmed sticker assembly instead of the trimmed sticker assembly of claim 1.

(5) The evidence of obviousness (e.g. German 696's teaching to use a window sticker mounting aid to facilitate detachment of sticker from a window and Courtney's teaching to trim a mounting aid to make the mounting aid virtually undetectable to the casual observer) outweighs the evidence for non-obviousness (e.g. Kassab's 132 declaration).

Appellant's arguments regarding the commercial success on pages 36-37 of the Brief filed 3-30-06 are not persuasive for the reasons given above; it being emphasized that appellant has the burden to prove commercial success commensurate in scope with the claims and appellant has failed to meet that burden. Note that the evidence in the 132 declaration fails to define "My product". Assuming that the "My product" sold is not trimmed, paragraph 10 fails to describe what percentage of the products sold are actually trimmed in use.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

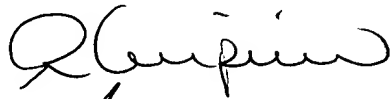
Respectfully submitted,


STEVEN D. MAKI
PRIMARY EXAMINER 5-28-06

Steven D. Maki
May 28, 2006

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